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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,254	12/17/2001	Alexander Goen Szynalski	NutriMerica	4735

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,254

Applicant(s)

SZYNALSKI, ALEXANDER GOEN

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 8, 12, 14-17, 20, 23, 27, 29-32, 35, 38, 42, 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Goen Seminars Stop Smoking Workbook ("Goen"). Goen discloses a method and system for helping a subject to stop smoking comprising a non-conditional educational program, a hypnosis program and a substance selected from the recited group. In particular, pages 3-5 of the workbook comprise a non-conditional educational program which educates the conscious mind to discourage smoking, page 3 discloses the use of a hypnosis program to help the user stop smoking, and page 6 discloses the use of a vitamin supplement as part of the system. With respect to claims 2, 8, 12, 14, 15, 17, 23, 27, 29, 30, 32, 38, 42, 44 and 45, Goen discloses on page 6 the use of lobelia, which is a "stop-smoking substance" as well as a nicotine receptor antagonist, in an amount effective to aid in reducing a craving to smoke tobacco. With respect to claims 5, 20 and 35, Goen discloses on page 6 the use of vitamin supplements including vitamin C, calcium and magnesium.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 18, 19, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goen in view of Ferry, "Nicotine Dependence: America's 'Drug of Choice' " ("Ferry"). Goen discloses all of the limitations of the claims with the exception of the use of a weight control substance and the use of bupropion hydrochloride. Ferry discloses at page 11 (Section IX, H) the use of phenteramine to control weight. It would have been obvious to one of ordinary skill in the relevant art to modify the method and system disclosed by Goen by providing a weight control substance for the purpose of reducing nicotine craving. Ferry also discloses at page 10 (Section XIII, B) the use of bupropion hydrochloride as a stop smoking substance. It would have been obvious to one of ordinary skill in the relevant art to modify the method and system disclosed by Goen by providing bupropion hydrochloride for the purpose of assisting the user to stop smoking.

Claims 6, 7, 9, 11, 21, 22, 24, 26, 36, 37, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goen in view of Umbdenstock. Goen discloses all of the limitations of claims 6, 7, 21, 22, 36 and 37 with the exception of the use of dietary supplements including gotu kola and kava kava. Umbdenstock discloses in column 9, line 3 to column 10, line 20 the use of dietary supplements including gotu kola and kava

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kava as part of a program to curb an addiction. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Goen by providing dietary supplements including gotu kola and kava kava for the purpose of supplying needed nutrients to the user. With respect to claims 9, 11, 24, 26, 39 and 41, kava kava is an anxiolytic.

Claims 9, 10, 24, 25, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goen in view of Gawin. Goen discloses all of the limitations of claims 9, 10, 24, 25, 39 and 40 with the exception of the use of an anxiolytic drug. Gawin discloses in column 5, line 14 to column 6, line 37 the use of anxiolytic drugs as part of a program to curb an addiction. Gawin further discloses in column 3, lines 21-67 that the drugs can be used to help curb a nicotine addiction. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Goen by providing an anxiolytic drug for the purpose of assisting the user in curbing a nicotine addiction.

Claims 9-12, 25-28 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goen in view of Cary. Goen discloses all of the limitations of claims 9, 10, 24, 25, 39 and 40 with the exception of the use of an anxiolytic drug. Cary discloses in column 2, lines 48-56 the use of anxiolytic drugs as part of a program to curb a nicotine addiction. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Goen by providing an anxiolytic drug for the purpose of assisting the user in curbing a nicotine addiction.

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Coen discloses all of the limitations of claims 12, 13, 27, 28, 42 and 43 with the exception of the use of a nicotine receptor antagonist drug. Cary discloses in column 2, line 57 to column 3, line 62 the use of nicotine receptor antagonist drugs as part of a program to curb an addiction. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Goen by providing a nicotine receptor antagonist drug for the purpose of blocking physiologic, behavioral and reinforcing effects of nicotine. With respect to claims 14, 15, 29, 30, 44 and 45, Goen discloses the use of lobelia, as discussed above. Lobelia is a nicotine receptor antagonist.

Response to Arguments

Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's argument that Ferry does not qualify as prior art, because it cannot be established that the reference was published more than 1 year prior to applicant's priority date of October 25, 1999, applicant is incorrect on this point as a matter of law. 35 USC 102(b) requires that a prior art document be published more than one year before the effective filing date. However, 35 USC 102(a) reads as follows:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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The only requirement is that the reference be published before the effective filing date of the application. Perry bears a copyright date of 1998, which is earlier than the effective filing date of October 25, 1999, and thus qualifies as prior art under 35 USC 102(a). Because 35 USC 103 incorporates all of 35 USC 102, and not only 35 USC 102(b), Perry qualifies as prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant is incorrect, as a matter of law, that 35 USC 103 requires that some reference must say, in particular, to combine two specific references together. In this case, all of the secondary references are explicitly directed to methods and systems for curbing a nicotine addiction, and all of the substances disclosed therein are specifically taught, in the secondary references, as being helpful in curbing nicotine addiction. As one example, Cary recites at column 3, lines 8-11, that "[in] the context of nicotine dependence, mecamylamine HCl has been shown to block many of the physiologic, behavioral, and reinforcing effects of nicotine." This is not some made-up reason for combining the references; this is a specific hint, directly quoted from Cary, as to why someone of ordinary skill would include a nicotine receptor antagonist in a system to help a user

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stop smoking. Thus, the present invention is disclosed or suggested when viewing the prior art as a whole.

Because new grounds of rejection are presented herein, this action is made non-final.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
April 8, 2004

Kurt Fernstrom
Kurt Fernstrom